

REMARKS

The allowance of claim 39 is noted with appreciation, and also that there have been no rejections on prior art. Claims of this application have been copied from issued patent 6,176,862 B1 (Delay et al.). Applicants' priority filing date (June 14, 1995) and their PCT filing date (June 4, 1996) are each senior to both Delay et al.'s filing date (May 12, 1999) and his foreign priority date (September 16, 1997) by more than one year, and thus would be entitled to senior party status were Examiner to initiate an Interference proceeding.

A new set of dependent claims (40-50) is added depending from allowed claim 39, these claims being identical to the dependent claim set of claim 24. The undersigned indicated in the previous Response filed March 19, 2003, at pp. 7-8 therein, that he reserved the right to add such claims if claim 39 were found patentable but not claim 24, in order that an appropriate number of dependent claims are available to correspond with the claims of Delay '862. Claims 40-49 correspond identically to pending claims 25-34 herein, and claim 50 to pending claim 37.

I. Rejection under §112, first para.

The Examiner questioned use of the claim language that the protuberance extends beyond the tweezing edges of the tweezing blades. Support for this was discussed with Examiner in a telephone conference of July 22, 2003, which appeared to have been favorably received initially and which Examiner indicated he wished to consider further. Subsequent efforts to contact Examiner were unsuccessful, so the undersigned, desiring to file a Response after Final within 2 months, is presently filing this paper, and is prepared at any time to telephone with Examiner to advance this case.

In the phone conference, support was indicated for claims 24 and 38 at several locations in the specification as filed. The same arguments apply to both claims. However, it is noted that the grounds for the rejection (page 2 of the Office Action) cannot apply equally to both claims, since only claim 24 includes the language "in a fixed position", which is not present in claim 38. It is respectfully submitted that Examiner overlooked this distinction in the Office Action at pages 2-3; this is relevant to the below discussion of the Figure 2 embodiment.

A. Since the embodiment shown in Figure 2, as well as its variants, is important to the arguments, it will be discussed first. The term "threading" devices 6 refers to fact that the disc-shaped plates also form channels between them that guide hairs to the tweezer edges. In operation, the elements 16 extend beyond the threading device to impact the skin. Figure 2 illustrates the elements 16 both in their retracted position 22 and in their advanced position 23. The threading device 6 is shown in Fig. 2 with reference numeral 7 (representing a row of threading devices 6, see page 14, line 2); the tweezer edge 4 is shown in Fig. 2 with reference numeral 5 (representing a row of tweezing blades 4, see page 14, line 5). The text at page 14, lines 26-32 states that the "advanced position 23" of the skin-impact elements has a diameter 26 that exceeds the maximum diameter 25 of the tweezing blades 4. That text also states that the elements in the "retracted position 22" are at a diameter 24 that is less than or equal to the maximum diameter of the tweezing blades 4.

B. The Embodiment of Figure 2 Supports Claims 24, 38:

The embodiment of Figure 2 as illustrated and as described on page 14, lines 23-32 supports Claim 38, which does not recite the feature of the elements being mounted "in a fixed position" on said roller.

The variant embodiment of Figure 2 as illustrated and as described on page 15, lines 28-32 supports Claim 24, which does recite the feature of "a fixed position non said roller".

The specification states at page 15, lines 28-32:

"Provided the element 16 protrudes in its advanced position 23 by only a small degree or marginally *beyond* the maximum diameter 25 of the clamping device 4, it may be possible in certain cases to *dispense completely with moving* the element 16 to its retracted position 22." (emphasis added)

Thus, the specification discloses a variant of the embodiment illustrated in Figure 2, wherein the skin-impacting elements are mounted in a fixed position on the roller, and this position is called "the advanced position 23" and corresponds to that shown in Fig. 2. In this variant, since the elements extend by a small amount beyond the clamping device 4, the person of ordinary skill omits structure that provides for them to move radially inward to a "retracted position 22".

It is also shown in Figure 2 that the radial extent of the threading device is the same as that of the tweezing edges. Hence, since the advanced position 23 exceeds the diameter of the threading device, then a virtual cylinder constructed there also includes within it the tweezing edges.

Claims 24 and 38 are supported for this reason.

C. The Embodiment of Figure 8 Supports Claims 24, 38:

First, it is noted that the text first describes the Figure 2 embodiment, then discusses various embodiments of the element 16 with respect to Figs. 3-4 (page 16, middle), then discusses various mechanisms to generate reciprocating movement in Figs. 5-7 (page 16, bottom), then building further off of the embodiment shown in Figure 2, the text states at page 17, line 29, that "Other embodiments of the element 16 become apparent from Figures 8 and 9", indicating that Figure 8 shows the additional material to understand an alternate construction, and through an economy of language avoids repeating what the person of ordinary skill understands is carried over from Figure 2.

Secondly, the text at page 17, lines 31-33 states with respect to Figure 8 that "it is thus possible for the element 16 to be configured as a protuberance 35 that is positioned *on* the free end 36 of a threading device 6 and hence connected to the rotary cylinder 10 (emphasis added)." Thus, the element is on top of the surface discussed. The description continues at page 18, lines 4-7 that the protuberance moves from "the advanced position 23" upon striking the skin "into the retracted position 22". These are the same respective positions, identified with the same reference numerals, as in the description to Figure 2 discussed above. Note that the only illustration of reference numerals 22, 23 is found in Fig. 2 (and in another of its alternates, Fig. 7, which is not presently under discussion). It is clear that the same positions and relative relationships are being referred to as in the text accompanying Figure 2.

Thirdly, as has been discussed with respect to the description of Figure 2, the elements in the retracted position 22 are at a diameter 24 which is inside or flush with the tweezing edges 4, 5 (and the threading device 6, 7), and the elements at the advanced position 23 are at a diameter 26 which "is greater than the maximum diameter 25 of the clamping devices 4", see page 14, line 30-32.

Thus, in the embodiment of Figure 8, the elements in their free state are in the advanced position 23 which extends beyond the tweezing edges.

Thus, for this additional reason, claims 24 and 38 are supported by the embodiment that is particularly described with respect to Figure 8.

D. Claims 35 and 36 are cancelled, and claims 30 and 37 amended to be consistent with support therefor seen in the embodiment of Figure 8. Claims 35 and 36 were not distinct from Delay '862's claims 12-13, respectively, which were drawn to the embodiments shown in his Figs. 8b, 8c, respectively, and his claims 12-13 are still not distinct from present claim 33 (the analog to Delay claim 10). Claims 30 and 37 continue to correspond to Delay claims 7 and 14, respectively.

New Claims:

To advance the prosecution, and because it was not possible to telephonically contact the Examiner before filing this paper by July 30, 2003, two new independent claims are added, Claims 51 and 52, which are identical to each of claims 24 and 38 with the exception that the following change is made in the fourth paragraph of each of the claims:

... and each element has at least one protuberance extending beyond a virtual cylinder coaxial with said roller and [in] which intersects an outer surface of said roller [are inscribed said tweezing edges of said tweezing blades].

Thus, these new claims are believed free of the matter that Examiner objected to under §112, 1st para. as applied to claims 24, 38. In the event that the rejection of claim 24 and 38 is maintained but that either of Claims 51 or 52 is allowed, then the undersigned requests the opportunity to substitute claim 51 for claim 24 (or claim 52 for claim 24 if claim 51 is not allowed but claim 52 is), in order that a set of dependent claims is available for interference. It is again noted that claims 38 and 52 each omit the reference to the elements' mounting *in a fixed position* to the roller as is stated in claims 24 and 51.

It is requested that if Examiner considers maintaining any §112 rejections, that he first telephone the undersigned who will then cooperate with Examiner to quickly place the application in condition for the claims to be found patentable.

The present claims and claims of Delay are directed to the same invention:

Applicants re-present the following remarks that were made in the Preliminary Amendment:

The invention of the present claims has as its purpose, as Delay et al. '862 (hereinafter "Delay") states at column 3, lines 23-27, that the painful stimulus of the hair tweezing is masked by overloading the nerves through the additional imposed, repetitive mechanical stimulus to massage the skin in a comfortable manner (see also col. 8, ln. 35). The present application identically states that the overlaid pulse overshadows the actual epilating pain by saturating the nerve, see carryover text at page 2, lines 15 to page 3, line 8.

Delay uses pain-masking elements that are pins or protuberances that are at their base (or proximal) ends attached to the rotary member, and at their free, skin-engaging (or distal) end extend beyond the virtual cylinder (an imaginary mantel surface) inscribed around the roller. In both Delay and the present application the elements are connected to the roller at a fixed angular position, as is claimed in Claim 39. The specification teaches that to achieve the pain-masking result, the free end extends by an amount between 0.1 mm and 1mm (see Fig. 2, and e.g. col. 9, ln. 6); this falls within the identical range taught by the pain-masking elements of the present invention, which extend beyond the virtual cylindrical surface by a similar amount of 0.1 mm to 6 mm, see specification at page 14, line 34 and e.g. Figures 2, 8 or 9.

Indication of Other Proceedings:

It is noted that in a continuation application stemming from a common parent application (Ser. 08/996,991), that the present Applicants' US Ser. 09/444,643 (their Docket B06090-A) has been allowed but in which prosecution on the merits is suspended pending a determination of initiating an Interference against US Pat. 5,893,854 (Bontoux et al.), which is also assigned to the company SEB of Ecully, France, which is also the assignee of the Delay US Pat. 6,176,862. Thus, the

Patent Office may wish to be aware, in the interests of economy, that the two matters involve the same two parties.

If a telephone conference would helpfully advance prosecution, the Examiner is invited to telephone the undersigned at 617-421-7939. Please apply any charges or credits to Deposit Account No. 07-1350.

Respectfully submitted,



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## APPENDIX

Marked-Up Version showing additions and deletionsIn the Claims:

--30. (Twice amended). Hair-removing device according to claim 24, wherein said elements are present in the form of at least one radial plate having an external edge, [or a bar having an external edge,] said external edge of said plate [or of said bar] protruding beyond the virtual cylinder.

--33. (Amended) Hair-removing device according to claim 24, wherein said roller comprises peripheral pedestals arranged extending parallel to the axis of rotation of said roller and each having an external face, and wherein said elements are mounted on said external faces of said pedestals.

--37. (Amended). Hair-removing device according to claim 33, wherein each of said pedestals has an oblique external face and each of said elements [constitutes a protruding] is formed along an elongated edge [of the oblique external face] of a respective one of said pedestals, said [protruding] elongated edge [of said oblique external face of each] of said pedestals being an upstream or downstream edge [of said oblique external face] as viewed with respect to the sense of rotation of said roller [, and said protruding elongated edge of said oblique external face of each of said pedestals is straight, undulating, or toothed] . --